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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,416	04/18/2001	Cheng-Shing Lai	LAIC3002/EM/6695	6853

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EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/836,416

Applicant(s)

LAI ET AL.

Examiner

Azizul Choudhury

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Detailed Action***

This office action is in response to the correspondence received on October 19, 2004.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Birrell et al (US Pat No: US006185551B1), hereafter referred to as Birrell.

1. With regards to claim 1, Birrell teaches a method of enabling an electronic communication apparatus to receive a long e-mail message from an Internet server, including the steps of: driving POP3 (Post Office Protocol 3) of the communication protocol of the network communication software installed in the electronic communication apparatus to receive a head message of the e-mail message upon detection of the presence of said e-mail message in said internet server, and to send the head message to an upper module block said electronic communication apparatus; driving said upper module block to judge if the length of said e-mail message surpasses a maximum length receivable to said electronic communication apparatus; driving said POP3 to receive data of said e-mail message if the length of said e-mail message is within the maximum length receivable to said electronic communication apparatus;

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driving said POP3 to receive said e-mail message segment by segment subject to the maximum length receivable to said electronic communication apparatus if the length of said e-mail message surpasses the maximum length receivable to said electronic communication apparatus, and then to send the received e-mail message segments to the upper module block of said electronic communication apparatus one after another, for enabling said upper module block to register the received e-mail message segments in corresponding storage zones; driving said POP3 to give a message to said upper module block when the last e-mail message segment of said e-mail message has been received, informing said upper module block that all of the e-mail message segments of said e-mail message have been well received; driving said upper module block to connect said e-mail message segments of said e-mail message one after another to form a complete e-mail message for storage, after all e-mail message segments have been received and registered in corresponding storage zones (Birrell teaches a design about an email system (column 1, line 63 – column 2, line 6, Birrell). As in all email systems, emails contain headers (column 9, line 11, Birrell). The client receives headers first since they contain crucial information such as the routing information (column 9, line 14, Birrell). In addition, Birrell's design has means by which to determine the size of the email and determine if an email is too large (column 12, line 62 – column 13, line 24, Birrell). If a message is too large, the acceptable portion of the email is sent, and the excess portions such as attachments are accessible through a link attached to the email. This allows the entire email to be accessed. Plus, Birrell discloses that the design allows for the use of SMTP (column 3, lines 30-40, Birrell).

SMTP allows for the measuring of email sizes and places limits on sizes of emails. The email that is sent, just as any data that is sent in a network is sent in packets (equivalent to the claimed segments). Hence, just as claimed, in Birrell's design, the email is sent in packets and is received one after another and combined into a full data by the client (just as TCP/IP protocol requires), and portions are left out if the email is too large. Finally, Birrell's design makes use of POP 3 protocol for emailing (column 6, lines 13-15, Birrell)).

2. With regards to claim 6, Birrell teaches the method wherein said communication protocol of said network communication software installed in said electronic communication apparatus is TCP/IP (Transmission Control Protocol/Internet Protocol) (Birrell's design allows for the use of TCP/IP (column 3, line 19, Birrell)).

3. With regards to claim 7, Birrell teaches the method further comprising the step of driving said upper module block to connect all e-mail message segments to the head message data one after another (The email that is sent, just as any data that is sent in a network is sent in packets (equivalent to the claimed segments). In addition, Birrell's design uses TCP/IP (column 3, line 19, Birrell). TCP/IP requires data to be transferred in packets one after another. The receiving device receives these data packets where they are combined to form a single data entity as claimed. The header is part of the email and must be part of the email (column 9, lines 11-15, Birrell)), hence since the data

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packets are combined to form a single data entity (email message), the header must be combined with the data as well, as claimed).

4. With regards to claim 8, Birrell teaches the method further comprising the step of driving said upper module block to connect currently received e-mail message data to the head message email that is sent, just as any data that is sent in a network is sent in packets (equivalent to the claimed segments). In addition, Birrell's design uses TCP/IP (column 3, line 19, Birrell). TCP/IP requires data to be transferred in packets one after another. The receiving device receives these data packets where they are combined to form a single data entity as claimed. The header is part of the email and must be part of the email (column 9, lines 11-15, Birrell), hence since the data packets are combined to form a single data entity (email message), the header must be combined with the data as well, as claimed).

### ***Response to Remarks***

The amendment received on October 19, 2004 has been carefully evaluated, but is not deemed fully persuasive. While it is appreciated that amendments have been made, the claimed design continues to remain vulnerable to existing prior art. The following are brief responses to the issues presented in the amendment.

With regards to the remark that the claimed design sends segments whereas the Birrell art presents a design simply using TCP/IP, the term "segment" is broad and remains vulnerable to the data segment concept found in TCP/IP. First, the use of the

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term "segment" is general and is applicable to the data segments (also called blocks or packets) found in TCP/IP data transfers. Second, the claimed segments are transferred over the network and then combined to create an email. Such actions of the claimed segments sound equivalent to the actions performed on data segments/packets of TCP/IP network transfers. When an email is sent over TCP/IP, it is broken into data segments/packets and is then combined together to form the email message. The examiner is not stating that the applicant's design lack novelty versus the Birrell prior art. The examiner however does believe that the claimed invention lacks novelty and remains vulnerable to the Birrell prior art. For instance, stating that an email message is broken into smaller messages, where each message is sent separately and later combined, states a design that is not vulnerable to the Birrell prior art.

With regards to the remark that the Birrell art does not send the entire email message, the examiner disagrees. When a message is too long to be sent, only the permissible amount is sent with a link accessing the remainder of the email. When a user selects the link, the remainder of the email message is presented to the user. This allows the entire email to be accessed and viewed by the user.

Finally, as stated above, Birrell's design allows for the use of SMTP. SMTP places size limits to emails and allows client software to select desirable maximum and minimum limits with regards to email messages.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC

  
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